

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicants: John BOAKES, et al.

SEP - 6 2002

Application No.: 09/684,662

TECHNOLOGY CENTER 2800

Filing Date: October 10, 2000

Title: ANTENNA ASSEMBLY AND METHOD OF CONSTRUCTION

Art Unit: 2821

Examiner: H. Le

REQUEST FOR COMPLETE OFFICE ACTION AND FOR  
WITHDRAWAL OF FINALITY OF OFFICE ACTIONAssistant Commissioner for Patents  
Washington, D.C. 20231

September 5, 2002

Sir:

Applicants gratefully acknowledge the Office Action dated June 5, 2002. Applicants respectfully request that: 1) the Office Action be corrected or supplemented to include the prior art relied upon for the rejection of claims 13, 14 and 35-42; and/or 2) the finality of the Office Action be withdrawn.

Background

The first Office Action dated October 11, 2001 rejected all of the then pending claims (claims 1-24 and 27-52) as being anticipated by either one of two prior art patents. In the Amendment filed on April 10, 2002, applicants traversed the rejections. Applicants submitted separate arguments for several different groups of claims. Relevant to this Request, applicants submitted arguments directed specifically to dependent claims 13 and 35-38 (see pages 8-9), arguments directed specifically to dependent claims 14 and 39-42 (see pages 9-10), and arguments directed specifically to claims 22-24 (see page 11).

The next Office Action was mailed on June 5, 2002 and is the subject of this Request.

The Office Action was made final and includes four separate prior art rejections based on three different prior art patents. The second and third rejections, respectively set forth in part 5 on page 4 and part 6 on pages 4-5, reject claims 22-24 as being anticipated by two newly cited prior art references. The fourth rejection, set forth in part 8 on page 5 of the Office Action, rejects claims 13, 14 and 35-42 by taking Official Notice that the two features of claims 13, 14 and 35-42 are "notoriously well known."

### **The Office Action is Incomplete**

Official Notice can be taken based on common knowledge in the art or "well-known" prior art. See MPEP 2144.03. However, the taking of Official Notice is inappropriate when an applicant makes arguments that create a reasonable doubt regarding the circumstances justifying the judicial notice. See In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (cited in MPEP 2144.03).

In this application, applicants' previous arguments directed specifically to dependent claims 13 and 35-38 and applicants' previous arguments directed specifically to dependent claims 14 and 39-42 made clear that applicants believed those claims to be allowable for reasons in addition to the reasons for the independent claim. Obviously, applicants would not have separately and specifically argued for the patentability of those claims if applicants believed them to be notoriously well known. The subsequent taking of Official Notice, after applicants made specific arguments that the features of those claims are not in the prior art, fails to advance the prosecution with respect to those claims and is not justified. Applicants respectfully request that the Office Action be corrected or supplemented to include prior art being relied upon for the rejection of claims 13 and 35-38 and for the rejection of claims 14 and 39-42 rather than merely taking Official Notice.

**The Office Action should not be Final**

In the Amendment filed on April 10, 2002, claim 22 was amended merely to be in independent form in view of the cancellation of claims 20 and 21 upon which it originally depended (see page 11). The substantive scope of claim 22 was not changed by the Amendment. Therefore, the second and third rejections of claims 22-24, based on newly cited prior art, was not necessitated by applicant's amendment. Applicants acknowledge that the rejection of claim 1 (and other claims) was necessitated by applicants' amendment. However, it is not proper to make an Office Action final if it contains a new grounds of rejection not necessitated by applicant's amendment in spite of the fact that other claims may have been amended to require newly cited prior art. See MPEP 706.07(a), Eighth Edition, page 700-57, second column.

It is believed that no fees are necessary for this Request. However, please charge any fees necessary for the consideration of this Request, or any other fees necessary for the consideration of this application, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (367.39057X00).

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

  
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